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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/596,699	06/22/2006	Gilad Rafaeli	1416/20	6952
7590	08/30/2007			
Mark Friedman Bill Polkinghorn 9003 Florin Way Upper Marlboro, MD 20772			EXAMINER SMITH, SCOTT A	
			ART UNIT 3721	PAPER NUMBER
			MAIL DATE 08/30/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/596,699

Applicant(s)

RAFAELI, GILAD

Examiner

Scott A. Smith

Art Unit

3721

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/14/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 11-20, as originally presented, need to be amended and renumbered as claims 10-19.

The action below will refer to the claim numbering as originally presented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9, the recitation of "a accessory" is grammatically awkward. It is suggested that "a" be changed to "an".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 3721

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8, 12, 13, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hilti '209.

Hilti '209 discloses the nail guiding device as claimed comprising a sleeve 106a partially covered by a flexible membrane 117 which inherently has an opening therein for holding nails, and a piston 118a slidable in the sleeve for driving nails, wherein the piston has a concave surface 119a which engages a nail head.

Claims 1, 2, 4, 7-9, 12-17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Fields '755.

Fields '755 discloses the nail guiding device as claimed comprising a sleeve 106a partially covered by a flexible rubber membrane 22 which has an opening therein for holding nails, the opening having a round portion on an end and a slit portion 34 (Note: Fig. 2), a piston 38, 54 slidable in the sleeve for driving nails, and a storage compartment as part of the piston, which is also with and inherently part of the sleeve.

Claims 1, 2, 4, 8, 9, 12, 13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoffman '974.

Hoffman '974 discloses the nail guiding device as claimed comprising a sleeve 10 with a storage compartment 31 therein, the sleeve being partially covered by a flexible membrane 13 which has a round opening therein 14 for receiving and guiding nails, and a piston 24 slidable in the sleeve for driving nails.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-7, 14, 15, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilti '209.

Hilti '209 lacks the membrane attachment methods, as per claims 5 and 6, the opening in the membrane being in the form of a slit, and are silent as to the membrane composition. Rubber is a well-known resilient composition, and gluing and injection molding are well known expedients for securing components together. Therefore, it would have been obvious to one skilled in the art to form the resilient membrane of Hilti '209 from rubber, as well as attaching the membrane via gluing or injection molding since to do so provides no new and unexpected results. Further, to provide the membranes with slits for the opening shape would have been obvious, since to do so provides no new and unexpected results.

Claims 5-7, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman '974.

Hoffman '974 lacks the membrane attachment methods, as per claims 5 and 6, the opening in the membrane being in the form of a slit, and are silent as to the membrane composition. Rubber is a well-known resilient composition, and gluing and injection molding are well known expedients for securing components together.

Therefore, it would have been obvious to one skilled in the art to form the resilient membrane of Hoffman '974 from rubber, as well as attaching the membrane via gluing or injection molding since to do so provides no new and unexpected results. Further, to provide the membranes with slits for the opening shape would have been obvious, since to do so provides no new and unexpected results.

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fields '755.

Fields '755 lacks the membrane attachment methods, as per claims 5 and 6. Gluing and injection molding are well known expedients for securing components together. Therefore, it would have been obvious to one skilled in the art to attach the membrane of Fields '755 via gluing or injection molding since to do so provides no new and unexpected results.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoffman '974, Fields '755 or Hilti '209 in view of Arena '632.

Hoffman '974, Fields '755 and Hilti '209 lack the sleeve having a level indicator. Arena '632 discloses a nail holding device 10 comprising a level indicator 38. In view of the teachings of Arena '632, it would have been obvious to one skilled in the art to provide the outer housing/sleeve of Hoffman '974, Fields '755 or Hilti '209 with a level indicator in order to ensure a proper orientation of a nail being driven relative to a workpiece.

Claims 16 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hilti '209 in view of Brunstetter '193.

Art Unit: 3721

Hilti '209 lacks the membrane having a slit opening. Brunstetter '193 discloses a similar device comprising a resilient membrane 30 having a slit opening 40 for retaining a nail 44. In view of the teachings of Brunstetter '193, it would have been obvious to one skilled in the art to form the opening in the membrane of Hilti '209 as a slit in order to more effectively retain the nail in position.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892 for related art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott A. Smith whose telephone number is 571-272-4469. The examiner can normally be reached on 5:30-4:00 Tues.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3721

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

S. Smith



**SCOTT A. SMITH  
PRIMARY EXAMINER**